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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,229	05/29/2002	Enok Tjotta	288748.0005	1742

7590

04/28/2003

Wilmer Cutler & Pickering  
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EXAMINER

RAMSUER, ROBERT W

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 04/28/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 (one) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-23 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claims 1-23 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

## **DETAILED ACTION**

### **Election/Restrictions**

This application contains groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous variables in the claims, e.g. Ar 1, Ar 2, X2, R1, X1, etc, (and the proviso: e.g. claim 13), and their widely divergent meanings, a precise listing of inventive groups can not be made. The following groups are exemplary:

Group I claim(s) 1, 11, 13-19, in part drawn to products of the formula (I) wherein Ar 1 and Ar 2 are phenyl, X2 is Oxygen, R1 X1 is OH and R2 is hydrogen or alkyl;

Group II claim(s) 1, 11, 13-19, in part drawn to products of the formula (I) wherein Ar 1 and Ar2 are phenyl, X2 is Oxygen R1 X1 is OH and R2 is alkyl substituted by phenylsulfonyl;

Group III claim(s) 20, drawn to a compound;

Group IV claim(s) 12, drawn to pharmaceutical compositions containing the compounds of group I (above) and Zidovudine;

Group V claim(s) 21-23 in part drawn to treating Addison's disease with the products of the formula (I) as defined in group I, above;

Group VI claim(s) 21-23 in part drawn to treating Bechet's syndrome with the products of the formula (I) as defined in group II, above.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhausted as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same.

The claims herein lack unity of invention under PCT Rule 13.1 and 13.2 since the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain a pyrazolidine group, which does not define a contribution over the prior art. The substituents on the pyrazolidine ring vary extensively and when taken as a whole result in vastly different compounds. Note also the known compounds

as depicted on page 1 of the specification.

Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Additionally, the vastness of the claimed subject matter, the provisos found in claims, and the complications in understanding the claim subject matter.

(e.g. compounds' with "for the manufacture of a medicament for use in therapy or prophylaxis, claim 1, and "for use as a medicament, claim 20), impose a burden on any search and examination of the claimed subject matter.

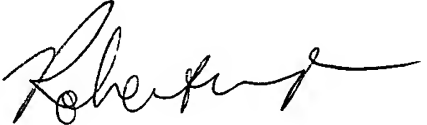
Applicant should elect a group or specific embodiment in response to this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Ramsuer whose telephone number is (703) 308-4534. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (703) 308-4537. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Ramsuer/LR  
April 8, 2003

  
Robert W Ramsuer  
Art Unit 1626